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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/538,136

06/09/2005

Takeshi Kimura

05361/GH

1531

1933 7590 08/06/2008  
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EXAMINER

SINCLAIR, DAVID M

ART UNIT

PAPER NUMBER

2831

MAIL DATE

DELIVERY MODE

08/06/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/538,136	<b>Applicant(s)</b> KIMURA ET AL.	
	<b>Examiner</b> DAVID M. SINCLAIR	<b>Art Unit</b> 2831	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/26/2008</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Withdraw of Finality***

1. Upon further consideration the Final Office Action mailed on 07/24/2008 is hereby withdrawn, a new Non-Final Office Action follows.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1-2 and 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over MT\_Shioya in view of JP54022596 hereafter referred to as Murata.

In regards to claim 1,

MT\_Shioya discloses a multilayer ceramic electronic part having an external electrode (3 – see fig.1) formed from a thermosetting conductive paste ([0010] – a thermosetting resin would make the conductive paste thermosetting) comprising conductive particles (4 – see fig. 1) having a high melting point ([0009]), metal powder (5 – see fig. 1) having a melting point of 300 °C or less ([0013] – teaches indium or tin as the surface substance both elements have a melting point of less than 300 °C) and a resin(s) (6 – see fig. 1). MT\_Shioya fails to teach the metal powder having a melting point of 300 °C or less is present in an amount by weight based on the total weight of said conductive particles having a high melting point and said metal powder having a melting point of 300 °C or less, of from of 5% to 17.6%.

Murata teaches a conductive paste used to form conductive layers on printed circuit boards wherein said conductive paste comprises conductive particles having a high melting point (Derwent – abstract; table 2 (page 4) - sample 3; Ag & Pd) and a metal powder composed of melting point of 300 °C or less (table 2 (page 4) - sample 3; Sn) wherein the weight percent of the metal powder having a melting point of 300 °C or less based on the total weight of said conductive particles having a high melting point and said metal powder having a melting point of 300 °C or less, is from of 5% to 17.6% (table 2 (page 4) – sample no. 3 – teaches 5 wt% Sn in the total compound [Sn is 8.92 wt% of all the conductive particles (conductive particles having a high melting point (Ag and Pd) and metal

powder having a melting point of 300 °C or less (Sn)]

$$\left( \frac{5(Sn)}{45(Ag) + 6(Pd) + 5(Sn)} \right) 100 = 8.92\% .$$

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the weight percent of Sn as disclosed by Murata with the conductive paste of MT\_Shioya to obtain an external electrode that is improved in solderability and antiweatherability.

In regards to claim 2,

The references as applied above teach all the limitations of claim 2 except the total content of said conductive particles having a high melting point and said metal powder having a melting point of 300 °C or less in said thermosetting conductive paste is in the range of 70 to 95% by weight relative to the total weight of said conductive particles having a high melting point, said metal powder having a melting point of 300 °C or less, and said resin. However, MT\_Shioya further teaches the total content of said conductive particles having a high melting point and said metal powder having a melting point of 300 °C or less in said thermosetting conductive paste is in the range of 70 to 95% by weight relative to the total weight of said conductive particles having a high melting point, said metal powder having a melting point of 300 °C or less, and said resin ([0014] – the conductive portion (conductive powder and conductive particles) is 100 weight parts and the resin is 30 weight parts therefore the conductive portion

compose 76.9% by weight relative to the total weight of said conductive particles having a high melting point, said metal powder having a melting point of 300 °C or less, and said resin).

In regards to claim 4,

MT\_Shioya teaches (1) providing a thermosetting conductive paste ([0010] – a thermosetting resin would make the conductive paste thermosetting) comprising conductive particles (4 – see fig. 1) having a high melting point ([0009]), metal powder (5 – see fig. 1) having a melting point of 300 °C or less ([0013] – teaches indium or tin as the surface substance both elements have a melting point of less than 300 °C) and a resin (6 – see fig. 1), and a ceramic composite body which is to be provided with an external electrode ([0015]); (2) printing or applying said thermosetting conductive paste on or to a surface where an internal electrode of said ceramic composite body is led out ([0015]); and (3) maintaining said ceramic composite body obtained in the step (2) at a temperature of 80 °C to 400 °C for a period of one to sixty minutes so as to form the external electrode ([0015]).

MT\_Shioya fails to teach the metal powder having a melting point of 300 °C or less is present in an amount by weight based on the total weight of said conductive particles having a high melting point and said metal powder having a melting point of 300 °C or less, of from 5% to 17.6%.

Murata teaches a conductive paste used to form conductive layers on printed circuit boards wherein said conductive paste comprises conductive particles having a high melting point (Derwent – abstract; table 2 (page 4) - sample 3; Ag & Pd) and a metal powder composed of melting point of 300 °C or less (table 2 (page 4) - sample 3; Sn) wherein the weight percent of the metal powder having a melting point of 300 °C or less based on the total weight of said conductive particles having a high melting point and said metal powder having a melting point of 300 °C or less, is from of 5% to 17.6% (table 2 (page 4) – sample no. 3 – teaches 5 wt% Sn in the total compound [Sn is 8.92 wt% of all the conductive particles (conductive particles having a high melting point (Ag and Pd) and metal powder having a melting point of 300 °C or less (Sn))]

$$\left( \frac{5(Sn)}{45(Ag) + 6(Pd) + 5(Sn)} \right) 100 = 8.92\% .$$

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the weight percent of Sn as disclosed by Murata with the conductive paste of MT\_Shioya to obtain an external electrode that is improved in solderability and antiweatherability.

In regards to claim 5,

The references as applied above teach all the limitations of claim 5 except the conductive particle in said external electrode makes a diffused junction with a metal of said internal electrode of said multilayer ceramic composite body.

However, the combination of MT\_Shioya and Murata further teach the conductive particle in said external electrode makes a diffused junction with a metal of said internal electrode of said multilayer ceramic composite body (the diffused junction is caused by the method of manufacturing therefore the method taught by the combination of MT\_Shioya and Murata which teaches the method of claim 4 would inherently create a diffused junction between the internal and external electrodes).

In regards to claim 6,

The references as applied above teach all the limitations of claim 6 except the multilayer ceramic electronic part is selected from the group consisting of a capacitor, a capacitor array, a thermistor, a varistor, an LC composite part, a CR composite part, an LR composite part, and an LCR composite part. However, MT\_Shioya further teaches the multilayer ceramic electronic part is selected from the group consisting of a capacitor, a capacitor array, a thermistor, a varistor, an LC composite part, a CR composite part, an LR composite part, and an LCR composite part ([0001]).

### ***Response to Arguments***

5. Applicant's arguments, see after final, filed 06/26/2008, with respect to the rejection(s) of claim(s) 1-2 & 4-6 under 35 U.S.C. 103(a) have been fully considered and



are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Murata.

Applicant argues the examiner's use of secondary reference Ogawa as teaching the weight percent. Applicant argues that Ogawa teaches an alloy and not a mixture and therefore there would be no reason to combine the teachings of an alloy with the teachings of a mixture of metals. The examiner has considered these arguments and found them to be persuasive.

### ***Communication***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID M. SINCLAIR whose telephone number is (571)270-5068. The examiner can normally be reached on Mon - Thurs. 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F. Gutierrez can be reached on (571) 272-2245. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Diego Gutierrez/  
Supervisory Patent Examiner, Art Unit 2831

/D. M. S./  
Examiner, Art Unit 2831